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APPLICANTS : PETER JAHN ET AL.
SERIAL NO. : 09/275,534
FILED : March 24, 1999
FOR : STATIC MIXER MODULE
ART UNIT : 1723
EXAMINER : D. Sorkin

February 24, 2004

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**COMBINED REQUEST TO WITHDRAW THE NOTICE OF ALLOWANCE
MAILED JANUARY 6, 2004 AND REQUEST FOR INTERFERENCE**

SIR:

REQUEST TO WITHDRAW THE NOTICE OF ALLOWANCE

The Notice of Allowance mailed on January 6, 2004, is erroneous in that Applicants requested a three-month suspension of action in the Request for Continued Examination (RCE) Transmittal filed on November 24, 2003. Please notice that Box 2(a) is checked on that form. Accordingly, action on the application should have been suspended at least until February 24, 2004. Consequently, the Notice of Allowance was erroneously mailed, and Applicants respectfully request that the Notice of Allowance be withdrawn.

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REQUEST FOR INTERFERENCE

The Request for Continued Examination was filed because Applicants believed that the claims of the instant application interfere with those of U.S. Patent No. 6,394,644. Therefore, in addition to withdrawing the Notice of Allowance, Applicants respectfully request that this application be placed into interference with U.S. Patent No. 6,394,644.

In accordance with 37 CFR § 1.607(a), an applicant can provoke an interference with an unexpired patent by:

- (1) Identifying the patent,
- (2) Presenting a proposed count,
- (3) Identifying at least one claim in the patent corresponding to the proposed count,
- (4) Presenting at least one claim corresponding to the proposed count or identifying at least one claim already pending in its application that corresponds to the proposed count, and, if any claim of the patent or application identified as corresponding to the proposed count does not correspond exactly to the proposed count, explaining why each such claim corresponds to the proposed count, and
- (5) Applying the terms of any application claim,
 - (i) Identified as corresponding to the count, and
 - (ii) Not previously in the application to the disclosure of the application.
- (6) Explaining how the requirements of 35 U.S.C. 135(b) are met, if the claim presented or identified under paragraph (a)(4) of this section was not present in

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the application until more than one year after the issue date of the patent.

In the present case, Applicants satisfy these requirements as follows:

(1) Identifying the Patent

The patent in question is U.S. Patent No. 6,394,644, issued on May 28, 2002, to Felix A. Streiff, of Humlikon, Switzerland, and assigned to Koch-Glitsch, Inc., of Wichita, Kansas.

(2) Presenting a Proposed Count

Applicants submit two proposed counts as follows:

COUNT 1

A device which is a static mixer module according to claim 23 of U.S. Serial No.
09/275,534

OR

a saddle element according to claim 1 of U.S. Patent No. 6,394,644.

COUNT 2

A device which is a mixer arrangement according to claim 12 of U.S. Serial No.
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OR

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a static mixer structure according to claim 21 or claim 22 of U.S. Patent No. 6,394,644.

(3) Identifying at Least One Claim in the Patent Corresponding to the Proposed Count

Applicants submit that claim 1 of U.S. Patent No. 6,394,644 corresponds to proposed Count 1.

Applicants submit that claims 21 and 22 of U.S. Patent No. 6,394,644 correspond to proposed Count 2.

(4) Presenting or Identifying at Least One Application Claim Corresponding to the Proposed Count

Applicants submit that claim 23 of U.S. Serial No. 09/275,534 corresponds to proposed Count 1.

Applicants submit that claim 12 of U.S. Serial No. 09/275,534 corresponds to proposed Count 2.

As these application claims correspond exactly to the proposed counts, there is no need to explain why such claims correspond to the proposed counts; this is only required if the application claims do not correspond exactly to the proposed counts.

(5) Applying the Terms of Any Corresponding Application Claim Not Previously in the Application to the Disclosure of the Application

Applicants submit that this requirement is not applicable inasmuch as application claims

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23 and 12, which are identified above as corresponding to proposed Counts 1 and 2, respectively, are not newly added, but were in the application prior to this request.

(6) Explaining How the Requirements of 35 U.S.C. 135(b) are Met

U.S. Patent No. 6,394,644 issued on May 28, 2002, which means that the critical date for the purposes of the 35 USC 135(b) requirements is May 28, 2003. Application claim 12 was an original claim in the Jahn application, which was filed on March 24, 1999, which is well in advance of the critical date of May 28, 2003.

Application claim 23 was added to the Jahn application in the Amendment under 37 CFR 1.116 filed on June 3, 2003. Although this date is after the critical date for purposes of 35 USC 135(b), the subject matter of claim 23, i.e., a static mixer module, has been claimed by Applicants since the application was filed. As further support for this position, Applicants point out that the Examiner did not consider the introduction of claim 23 to raise the issue of new matter or to raise the issue of the introduction of an invention patentably distinct from the claims then under consideration, thereby requiring restriction.

Further on this point, Applicants point out that main claim 1 as submitted in the Preliminary Amendment dated March 24, 1999, read as follows:

“1. Static mixer module (10), comprising a disc which is provided with a multiplicity of orifices (6) and which is structured on its front side (2) facing the mix and on its rear side (3) by means

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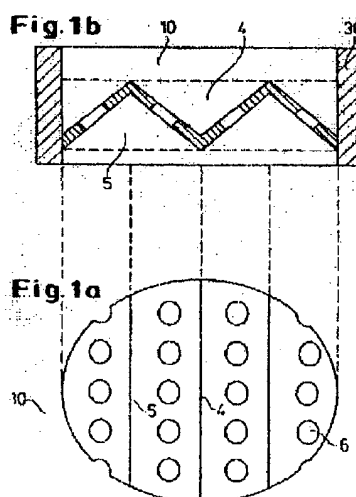
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of channels (4) and (5) running in parallel or concentrically, and in which the orifices (6) are made in the flanks (8) of the inlet channels (4) and open into the flanks (9) of the mixing channels (5).”

Dependent claim 5, as presented in that same amendment, read as follows:

“5. Static mixer module according to claim 1, wherein the inlet channels (4), the mixing elements (5), or both, have a *V-shaped*, U-shaped, rectangular or trapezoidal cross-sectional profile.”

These claims can be understood by understanding them in the context of instant Figures 1a and 1b:



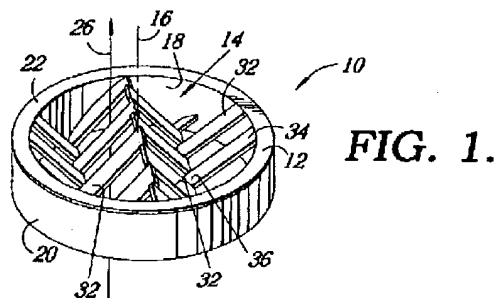
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It should be clear from Figure 1a that the present invention relates in one embodiment to a static mixer module, which comprises an element having generally a disc shape 10. The disc shown in Figure 1a is broken up into four bars, which, as shown in Figure 1b, can assume a V-shape, which is one of the possibilities claimed in original claim 5. Each of these four bars is interrupted by orifices (openings) 6, through which materials may pass. The static mixer module is intended to be inserted into a pipe 30, which has a circular cross-section.

Claim 23, although submitted after the critical 135(b) date, claims substantially this same concept as claimed by Applicants from the very beginning, in particular claiming that the four bars are arranged in a sawtooth pattern as shown in Figure 1b. Therefore, even though claim 23 was submitted after the critical 135(b) date, the requirements of 135(b) are satisfied.

Streiff Claims Substantially the Same Invention

Substantially this same invention is claimed by Streiff. This should be evident from Streiff's Figures 1 and 4:



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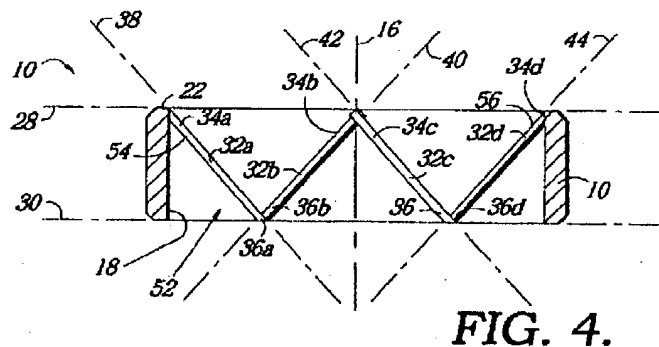


FIG. 4.

It should be clear that Streiff's saddle element comprises exactly the same sawtooth pattern. This feature is required by Streiff's claim 1 in that the mixer components are required to have a first end that is closer to the transverse plane of a first edge (28 in Figure 4) and a second end that is closer to the transverse plane of a second edge (30 in Figure 4); and the mixer components are required to be arranged in at least two separate oblique planes (38, 40, 42 & 44 in Figure 4.)

Further, Streiff requires that the sawtooth pattern contain holes in it. Thus, Streiff's claim 1 requires that the mixing components "are spaced apart to provide openings for fluid flow."

In other words, Jahn's claim 23 and Streiff's claim 1 *both* provide for a generally circular sawtooth element provided with holes as a static mixer element. While it is true that Streiff's claim 1 requires that this sawtooth element be provided in "a generally ring-shaped support

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structure,” such support structure is not excluded by Jahn’s claim 23 in view of the open-ended terminology “said module comprising,” and, as such, Jahn’s claim 23 embraces Streiff’s construct. See, 37 CFR § 1.601(n) (“Invention ‘A’ is the same patentable invention as an invention ‘B’ [thus, requiring an interference] when invention ‘A’ is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention ‘B’ assuming invention ‘B’ is prior art with respect to invention ‘A’.) Streiff’s claim 1 cannot be unobvious over Jahn’s claim 12 absent some objective evidence of nonobviousness.

Jahn’s claim 12 and Streiff’s claims 21 and 22 simply claim a mixer arrangement, wherein a plurality of mixer modules is arranged adjacent to one another.

Respectfully, in view of the foregoing, it should be clear that Jahn and Streiff claim substantially the same invention, and, therefore, the question of priority of invention needs to be sorted out.

Jahn Should be the Senior Party

In the event the expected interference is declared, Applicants respectfully submit that Jahn should be designated to be the senior party. On its face, the earliest date to which Streiff’s patent is entitled is the filing date of U.S. Provisional Application No. 60/140,336, which was filed on June 21, 1999. Jahn’s application was already filed in the United States prior to that date, on March 24, 1999. In addition, Jahn claims German priority. However, considering Jahn’s U.S. filing date alone, it is clear that Jahn should be designated the Senior Party in any